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Dated: April 27, 2010
Electronic Signature for Jeanne M. DiGiorgio, Esq.: /Jeanne M. DiGiorgio, Esq./

Docket No.: SHO-028US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Asuka Nishimura, et al.

Application No.: 10/566,593

Confirmation No.: 3574

Filed: August 17, 2006

Art Unit: 1638

For: GENES THAT CONFER REGENERATION
ABILITY TO PLANTS, AND USES THEREOF

Examiner: P. T. Bui

MS Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT UNDER 37 CFR § 1.705(b)(2)

Dear Sir:

1. This statement is respectfully submitted in support of the “Application for Patent Term Adjustment Including Request for Reconsideration Under 37 CFR §1.705(b)” in the above-referenced application. In view of the following, it is respectfully requested that Applicants be granted a patent term adjustment of **645 days** for the above-referenced application.
2. The patent term adjustment on the Determination of Patent Term Adjustment Under 35 U.S.C. §154(b) (“Determination”) that was attached to the Notice of Allowance is 416 days (a copy of the Determination is submitted herewith as Exhibit A). A copy of the USPTO’s Patent Term Adjustment calculation (“PTA Sheet”) available on Private Pair is also submitted herewith as Exhibit B. Applicants respectfully submit that the determination of 416 days of patent term adjustment is incorrect for the reasons discussed below.
3. The factual bases for the above adjustment are set forth as follows:

A. Examination Delays Pursuant to 37 CFR §1.702 and §1.703

Pursuant to 37 CFR §1.703(f), the period of adjustment of the term of the patent under §1.702 is the sum of the periods of Examination Delay calculated under § 1.703(a)-(e), to the extent that such periods are not overlapping, less the sum of the periods calculated under §1.704 (the period of Applicant Delay). In the above-referenced application, Applicants are entitled to a period of Examination Delay equal to the sum of the periods of delay under §1.703(a) and (b) for the reasons set forth below.

(i) “14 Month Delay” Pursuant to §1.703(a)(1)

In accordance 37 CFR §1.703(a)(1), Applicants are entitled to a period of patent term adjustment due to the failure by the Office to mail an action under 35 U.S.C. §132 not later than 14 months after the application fulfilled the requirements of 35 U.S.C. § 371 (*i.e.*, by October 17, 2006). As shown in the USPTO’s Patent Term Adjustment calculation (Exhibit B), the Office failed to mail an action under 35 U.S.C. §132 (a Restriction Requirement) until December 31, 2008. As such, Applicants are entitled to a period of patent term adjustment beginning October 18, 2006 and ending on December 31, 2008, the date of mailing of the Restriction Requirement by the Office. Accordingly, the period of patent term adjustment due to the 14 Month Delay by the Office is **441 days**. This is consistent with the PTA Sheet (Exhibit B) from the USPTO.

(ii) “Three Years Delay” Pursuant to 37 CFR §1.703(b)

It is anticipated that the Office will not comply with the requirement of 35 U.S.C. §154(b) and 37 CFR §1.702(b), which requires issuance of a patent within 3 years after the date the national stage commenced under 35 U.S.C. § 371 (b) or (f) (*i.e.*, August 17, 2009). As indicated in the Notice of Allowance, a patent is projected to issue on August 10, 2010. As such, there is an anticipated delay of **358** days.

(iii) “Four Month Response to Applicant Reply” Pursuant to 37 CFR § 1.702(a)(2) for delay in responding to Applicants Reply filed on September 21,2009

In accordance with 37 CFR § 1.720(a)(2), Applicants are entitled to a period of patent term adjustment due to the failure by the Office mail an action under 35 U.S.C. § 132 not later than four months after the date on which the reply was filed (*i.e.*, by January 21, 2010). As shown in the USPTO's Patent Term Adjustment Calculation (Exhibit B), the Office failed to mail an action under 35 U.S.C. 132 (a Notice of Allowance) until January 27, 2010. As such Applicants are entitled to a period of patent term adjustment of **6 days**. This is consistent with the PTA Sheet (Exhibit B) from the USPTO.

(iv) Calculation of Total Period of Examination Delay Pursuant to 37 CFR §1.703(f)

As set forth in 37 CFR §1.703(f), the period of examination delay based on the grounds set forth in 37 CFR §1.702 is the sum of the period of 14 Month Delay (441 days), the minimum period of Three Years Delay (358 days), to the extent these periods of delay are not overlapping, and the failure to respond to an Applicant response in four months (6 days). As the period of 14 Month Delay ended on December 31, 2008, prior to the first day of the period of Three Years Delay, *i.e.*, August 18, 2009, Applicants submit that these periods are not overlapping. However, Applicants also submit that the period of the Four Month Delay in responding to Applicants Reply (January 22, 2010 through January 27, 2010) overlaps with the Three Years Delay. Accordingly, the sum of the examination delay ($358 + 441 + 6 = 805$ days) is reduced by the period of overlap (6 days), resulting in a total examination delay of **799 days**.

B. "Applicant Delay" Pursuant to 37 CFR §1.704

Pursuant to 37 CFR §1.704 the period of adjustment of the term of the patent due to examination delay is reduced by the period of Applicant Delay. As shown in the USPTO's Patent Term Adjustment calculation (Exhibit B), the Office has calculated a period of Applicant Delay of 31 days. As described below, Applicants believe that the correct period of Applicant delay is **154 days**, and request that the USPTO review the calculation of Applicant delay and make appropriate corrections as necessary.

(i) Applicant Delay for Responding to Non-Final Action Dated May 21, 2009

Applicants respectfully submit that a period of Applicant Delay of **31 days** accrued for the delayed submission of an Amendment and Response on September 21, 2009. This is

consistent with the PTA Sheet (Exhibit B) from the USPTO. Accordingly, pursuant to 37 CFR § 1.704(b), this 31 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(ii) Applicant Delay for Filing a Supplemental Information Disclosure Statement on January 21, 2010

Applicants respectfully submit that an additional period of Applicant Delay of **123 days** accrued for the submission of a Supplemental Information Disclosure Statement on January 21, 2010. This Supplemental Information Disclosure Statement was filed 123 days after the filing of a Response to Non-Final Action by Applicants on September 21, 2009. Accordingly, pursuant to 37 CFR § 1.704(c)(8), this 123 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(iii) Calculation of the Total Period of Applicant Delay

In view of the above, Applicants have calculated a total period of Applicant Delay of **154 days**, which is the sum of the following Applicant Delays: (i) the 31 day period; and (ii) the 123 day period. Applicants note that this calculation differs from the USPTO's determination of 31 days of Applicant Delay, as shown on the PTA Sheet (Exhibit B). Accordingly, Applicants request that the USPTO review the calculation of Applicant delay and make appropriate corrections as necessary.

C. Calculation of Correct Patent Term Adjustment Pursuant to 37 CFR §1.703(f)

As set forth in 37 CFR §1.703(f), Applicants are entitled to a period of patent term adjustment equal to the period of Examination Delay reduced by the period of Applicant Delay. Therefore, Applicants submit that the correct patent term adjustment for the above-referenced application is **645 days**, which is the difference between the total period of Examination Delay (799 days) and the period of Applicant Delay (154 days).

4. In view of the foregoing, it is respectfully requested that this Application for Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term

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Adjustment be issued to reflect a patent term adjustment of **645 days** for the above-referenced application.

Dated: April 27, 2010

Respectfully submitted,

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